EXPEDITED PROCEDURE – EXAMINING GROUP 2151

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PATENT & TRADEMARK OFFICE

S/N 10/685,692 **PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: Mark Anderson et al. Examiner: Khanh Q Dinh
Serial No.: 10/685,692 Group Art Unit: 2151
Filed: October 14, 2003 Docket No.: 2054.001US5
Title: METHOD AND SYSTEM TO ASSOCIATE GEOGRAPHIC LOCATION INFORMATION WITH A NETWORK ADDRESS USING A COMBINATION OF AUTOMATED AND MANUAL PROCESSES

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
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Appellants request review of the Final Rejection dated 21 September 2005 and the Advisory Action dated 21 December 2005 in the above-identified application. Appellants respectfully traverse all rejections. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reason(s) stated below:

Claims 1, 2, 4-8, 12-16 and 18-22 and 25-30 were rejected under 35 U.S.C. § 102(e) for anticipation by Akatsu et al. (U.S. 6,523,064). Claims 3, 11 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Akatsu in view of Zoken (U.S. 5,944,787). These rejections are respectfully traversed.

Anticipation requires the disclosure in a single prior art reference of each element of the claims under consideration. *In re Dillon,* 919 F.2d 688, 16 USPQ2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991).

Col. 16, line 46 to col. 17, line 44 of Akatsu recites (emphasis added):

> "Referring to the first act depicted in FIG. 21, a test is performed by the home gateway 2700 at act 2804 to determine whether the location information stored in the positioning unit 2716 is current. Under normal circumstances, the test is performed on a regular, e.g., biweekly basis, so a counter/timer may be used to determine whether the geographic location information is current. Preferably the counter/timer is set to reflect an invalid time whenever a power off occurs, thereby forcing an update of the geographic location information. If the counter/timer is current, then the process continues to act 2816, otherwise, the process continues to act 2808.

> "In act 2808, *the processing unit 2716 retrieves geographic location information either automatically (e.g., through a global positioning module), or manually (e.g., through a user prompt and response).* In act 2812, the geographic location information is stored in a persistent memory in the home gateway 2700--e.g., NV memory 2712, or in a dedicated persistent memory (not shown) which is part of the positioning unit 2716.
>
> "In act 2816, incoming content information from the external network 904, which is passing through the external network interface 2704, is sampled. The sampled incoming data includes a channel identifier and can also include a broadcaster's time and date stamp. In act 2820, the sampled data is recorded in statistical data table 3000 (described in detail with reference to FIG. 23) residing in a persistent memory, e.g., NV memory 2712. In a preferred embodiment, each time a channel is changed on an IEEE 1394 node in the IEEE 1394 bus 568 for a period longer than a predetermined length of time, e.g., five minutes, the home gateway 2700 will create a corresponding record in the statistical data table 3000.
>
> "In act 2824, a test is performed to determine whether a request has been received for statistical geographic data. Generally, the statistical data request will come from the central server 2750 at a broadcaster's facility over the external network 904. However, the statistical data request can come from within the home entertainment network system 500, such as, for example, by a parent wishing to review a child's viewing habits.
>
> "If a statistical data request has not been received, then the present iteration of the process ends and the home gateway 2700 cycles back to act 2804. If, however, a statistical data request has been received by the home gateway 2700, then processing continues to act 2828, where the sampled data contained in the statistical data table 3000 is encrypted. According to an embodiment, a public key/private key encryption pair is used for the decryption/encryption mechanism, such as the Message Digest 5 "MD5" algorithm. The MD5 algorithm is described in the publicly available Internet RFC 1321, entitled, "The MD5 Message Digest Algorithm", R. Rivest, 1992, which is incorporated herein by reference in its entirety.
>
> "After the information from the statistical data table is encrypted, it is transmitted, together with the location identifier (if needed), over the external network interface 2704 to the central server 2750 at act 2832. Notably, if only particular home gateways 2700 having a particular location identifier are polled at any given time, then it may not be necessary to include the location identifier. However, if periodic updates are pushed from the home gateway 2700 to the central server 2750, then the location identifier becomes necessary. Thereafter, the present iteration of the process terminates and a new cycle can begin again at act 2804."

Appellants respectfully submit that independent claims 1, 15, 29 and 30 are not anticipated because Akatsu simply fails to teach each and every claimed element, including "if the automated process did not generate satisfactory geolocation information for the network address, *then forwarding of the network address for manual resolution*" as recited in claim 1, for example.

Col. 11, line 28 to col. 12, line 58 of Akatsu is specifically relied upon in the Action for "if the automated process did not generate satisfactory geolocation information for the network address, *then forwarding of the network address for manual resolution*" as recited in claim 1 (emphasis added). It is respectfully submitted that "*if the node unique ID is not found, then the node icon table is scanned for the desired node type (e.g., the node can be compliant with a particular device standard)*" as recited in col. 11, line 57 to col. 11, line 62 of Akatsu is, on its face, quite different than "if the automated process did not generate satisfactory geolocation information for the network address, *then forwarding of the network address for manual resolution*" as recited in claim 1 (emphasis added). In addition, the Action does not demonstrate equivalency between col. 11, line 57 to col. 11, line 62 of Akatsu and the current element of claim 1. Further, nothing within col. 16, line 46 to col. 17, line 44 and Figs. 13, 14 and 21 of Akatsu (reproduced above, and relied upon in the Action for the current claimed element) remedies these deficiencies. Because the Action does not show that these recited sections of Akatsu are indeed equivalent to the recited elements of claim 1, a *prima facie* case of anticipation has not been shown.

Even where the alternatives of using automatic or manual retrieval of geographic location information are discussed (see above-reproduced col. 16, lines 58-65 of Akatsu, for example), Appellants are unable to find a *link* between the manual resolution of Akatsu and whether "the automated process did not generate satisfactory geolocation information for the network address," as recited in claim 1.

Because all the elements of independent claim 1 are not found in Akatsu, Appellants assume that the Examiner is asserting that these elements are inherent in Akatsu. As recited in MPEP § 2112, "In relying upon the theory of inherency, the Examiner must provide basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art," citing Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

Appellants respectfully submit that the Office Action has not established a *prima facie* case of inherency. Again, the Action merely asserts that col. 11, line 28 to col. 12, line 58, col.

16, line 46 to col. 17, line 44 and Figs. 13, 14 and 21 of Akatsu discloses "if the automated process did not generate satisfactory geolocation information for the network address, then forwarding of the network address for manual resolution" as recited in claim 1 (emphasis added). The Office Action does not assert that the allegedly inherent characteristic is necessary in Akatsu, let alone provide a basis in fact and/or technical reasoning, as required to show inherency.

To serve as an anticipation when a reference is silent about the asserted inherent characteristic, the gap in the reference may be filled with recourse to extrinsic evidence of record. But, such evidence must make clear that "the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. v. Monsanto Co.,* 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

Because there is no evidence in the record to support such inherency assertions, the unsupported assertions appear to be personal knowledge of the Examiner. The Examiner is thus respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2).

Without the requisite extrinsic evidence, the Office Action has not made out a *prima facie* case of anticipation. Accordingly, independent claim 1 is patentable over Akatsu, and Appellants respectfully request that the rejection be withdrawn.

Independent claims 15, 29 and 30 are also asserted to be allowable for reasons similar to those presented above. Appellants consider elements of claims 15, 29 and 30 to further distinguish over the cited references, and Appellants reserve the right to present arguments to this effect at a later date.

Reconsideration of the independent claims 1, 15, 29, and 30 is respectfully requested. Further, withdrawal of the rejection of these independent claims 1, 15, 29, and 30, as well as for all rejected claims which depend from the allowable independent claims, is respectfully requested.

CONCLUSION

Appellants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Appellants' attorney Lucinda Price at 352-373-8804 (Gainesville, Florida) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

MARK ANDERSON ET AL.

By their Representatives,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 18 day of January, 2006.

Dawn R. Shaw
Name

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Signature